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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,528	08/22/2002	Richard McEwan	604.10-US1	5867

34284 7590 12/05/2006

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EXAMINER	
SHRESTHA, BIJENDRA K	
ART UNIT	PAPER NUMBER
3691	

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,528	MCEWAN ET AL.	
	Examiner	Art Unit	
	Bijendra K. Shrestha	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 14 November 2001 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 1/30/2002.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority this application # 09/980,528 filed on 08/22/2002 which is a 371 of PCT/US99/23781 filed on 10/12/1999.

Drawings

2. The drawings submitted on 10/15/2001 contain improper hand written text, which may affect clarity once reproduced. Appropriate correction is required.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 100. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "Registry of

recipient 's computer " must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: There are blank spaces at page 4, lines 17 and 20 in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 11-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. As per claim 11, applicant fails to point out distinctly its claim for time required to transmit 10% of commercial to recipients. Applicant indicates time required to transmit 10% commercials to recipients as within 24 hours, or within 2 hours and still more preferably within 30 minutes of production (see page 6, lines 12-15).

9. As per claim 12, applicant fails to point out distinctly its claim for time required to transmit 10% of commercial to recipients. Applicant indicates time required to transmit 10% commercials to recipients as within 24 hours, or within 2 hours and still more preferably within 30 minutes of production (see page 6, lines 12-15).

10. As per claim 13, applicant fails to point out distinctly its claim for ratio of number of commercial to number of targeted prospects. Applicant indicates on average at least one commercial for every 500 targeted prospects, or one commercial for every 50 prospects, or still more one commercial for every 10 prospects (see page 6, lines15-18).

11. As per claim 14, applicant fails to point out distinctly its claim for ratio of number of commercial to number of targeted prospects. Applicant indicates on average at least one commercial for every 500 targeted prospects, or one commercial for every 50 prospects, or still more one commercial for every 10 prospects (see page 6, lines15-18).

12. As per claim 15, applicant fails to point out distinctly its claim for ratio of number of commercial to number of targeted prospects. Applicant indicates on average at least one commercial for every 500 targeted prospects, or one commercial for every 50 prospects, or still more one commercial for every 10 prospects (see page 6, lines15-18).

13. As per claim 16, applicant fails to point out distinctly its claim for time required to transmit 10% of commercial to recipients. Applicant indicates time required to transmit 10% commercials to recipients as within 24 hours, or within 2 hours and still more preferably within 30 minutes of production (see page 6, lines 12-15).

14. As per claim 17, applicant fails to point out distinctly its claim for ratio of number of commercial to number of targeted prospects. Applicant indicates on average at least one commercial for every 500 targeted prospects, or one commercial for every 50 prospects, or still more one commercial for every 10 prospects (see page 6, lines15-18).

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claim 1 rejected under 35 U.S.C. 102(b) as being unpatentable by Dedrick (reference EE in the IDS submitted by the applicant).

17. As per claim 1, Dedrick teaches a method of conducting an advertising campaign, comprising:

selecting plurality of targeted prospects for the campaign (see Fig. 1; column 2, lines 62-65; column 11, lines 46-61);

identifying a marketing characteristics for at least some of the targeted prospects (see column 3, lines 43-56; where marketing characteristics such as demographic, psychographic and other profile information of targeted prospects are entered by prospects through graphical user interface (GUI and stored in personal profile database (see Fig. 3));

defining a group of component to be included in the campaign, for which there are at least two alternatives (see Fig. 3; column 4, lines 47-48; column 6, lines 33-51; where Content Adapter " 25" customizes electronic content format based on user profile data contained in personal profile database);

subsequently creating a new individualized commercial for each at least some of the plurality of targeted prospects by automatically assembling at least one of alternatives for each of the components in the group based on at least in part upon on the marketing characteristics (see Figs. 7a, 7b; where advertiser creates customized commercial based on information provided in the profile; Content Adapter "25"configures electronic content format based on user profile data); and

electronically transmitting at least one of the individualized commercial to a recipient having the marketing characteristics upon which the commercial transmitted is based (see Fig. 2; Fig. 7b; advertisement transmitted to end user is customized by client system based on data entered into consumer profile).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 2-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (reference EE in the IDS submitted by the applicant) in view of Fuller et al. (reference A in attached PTO-892).

20. As per claim 2, Dedrick does not teach the method of transmitting at least some of the commercials as executable files.

Fuller et al. teach method of transmitting at least some of the commercials as executable files (see Fig. 3; Fig. 5; column 9, lines 49-54; where advertisement modules files are executed as executable files).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate method of transmitting at least some of the commercials as executable files of Dedrick because Fuller et al. teach that these incorporation would give technical advantage in the sense that advertisers can track number of computer using software with their advertisements and how frequently the advertisement are being viewed (Fuller et al., column 5, lines 1-4).

21. As per claim 3, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick does not teach the method wherein at least some of the executable files are authenticated.

Fuller et al. teach the method wherein at least some of the executable files are authenticated (see Fig. 3; column 10, lines 15-23; where checksum routine checks the authenticity of the executable files).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein at least some of the executable files are authenticated of Dedrick because Fuller et al. teach that authentication of some executable files identifies whether the Adware program that contains advertisement has been altered or modified in any way (Fuller et al., column 10, lines 19-21).

22. As per claim 4, Dedrick in view of Fuller et al. teach claim 2 as described above. Dedrick further teaches the method wherein

the marketing characteristic is selected from the group consisting of age, sex, and income (Dedrick, column 3, lines 44-46).

23. As per claim 5, Dedrick in view of Fuller et al. teach claim 2 as described above. Dedrick further teaches the method wherein:

the marketing characteristic includes data obtained from information provided in response to a previous individualized electronic commercial (see Fig. 2; column 5, lines 34-49; where client activity monitor 24, tracks consumer variables corresponding to the preferences and stores in the personal profile database 27).

24. As per claim 6, Dedrick in view of Fuller et al. teach claim 2 as described above. Dedrick further teaches the method wherein:

the group of components includes at least three visual components and at least one audio component (see column 4, lines 44-55; where audio, video, graphic, animation and text format of advertisement is available but the group of component in any advertisement is as preferred by prospect stored in personal profile database).

25. As per claim 7, Dedrick in view of Fuller et al. teach claim 2 as described above. Dedrick further teaches the method wherein

at least one of the components comprises a video clip and at least another of the components comprises an audio clip (see column 4, lines 44-55; where audio, video, graphic, animation and text format of advertisement is available but the group of component in any advertisement is as preferred by prospect which is stored in personal profile database).

26. As per claim 8, Dedrick in view of Fuller et al. teach claim 2 as described above. Dedrick further teaches the method wherein at least one of the components comprises:

a video clip and at least another of the components comprises an audio clip, and at least a third component comprises a branding graphic distinct from both the video clip and the audio clip (see column 4, lines 44-55; where audio, video, graphic, animation and text format of advertisement is available but the group of component in any advertisement is as preferred by prospect stored in personal profile database).

27. As per claim 10, Dedrick in view of Fuller et al. teach claim 2 as described above. Dedrick in view Fuller et al. further teach the method wherein the step of

electronically transmitting comprises sending an e-mail through the Internet (see column 1, lines 17-20)

28. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (reference EE in the IDS submitted by the applicant) in view of Fuller et al. (reference A in attached PTO-892) as applied to claim 2 above and further in view of Makar et al. (reference B in attached PTO-892).

29. As per claim 9, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick in view of Fuller et al. do not teach the method wherein a variability in the group of components comprises a language employed on an audio clip.

Makar et al. teach the method wherein a variability in the group of components comprises a language employed on an audio clip (see Fig. 27; column 21, lines 12-15; column 10, lines 4-8; where users have choice of selecting American, Spanish, German, Chinese and Russian languages on messages received from advertisers).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the method wherein a variability in the group of components comprises a language employed on an audio clip of Dedrick in view of Fuller et al. because Makar et al. teach that the users has final say in what is displayed from list of preferences (Makar et al., column 5, lines 31-33).

30. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (reference EE in the IDS submitted by the applicant) in view of Fuller et al.

(reference A in attached PTO-892) as applied to claim 2 above and further in view of Roth et al. (reference C in attached PTO-892).

31. As per claim 11, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick in view of Fuller et al. do not teach the method wherein transmitting of at least 10% of the commercials occurs within 24 hours of their creation.

Roth et al. teach the method wherein transmitting of at least 10% of the commercials occurs within 24 hours of their creation (see column 5, lines 46-63; column 7, lines 26-33; where bids submitted by different advertisers are evaluated in real-time in order to determine which particular advertisement will be displayed to the consumer; transmission of all commercials occurs in real-time).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein transmitting of at least 10% of the commercials occurs within 24 hours of their creation of Dedrick in view of Fuller et al. because Roth et al. teach that the transmitting commercial in real-time provides a very flexible system whereby advertisers can minimize cost and maximize effectiveness (Roth et al., column 2, lines 66-67).

32. As per claim 12, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick in view of Fuller et al. do not teach the method wherein transmitting of at least 10% of the commercials occurs within 2 hours of their creation.

Roth et al. teach the method wherein transmitting of at least 10% of the commercials occurs within 2 hours of their creation (see column 5, lines 46-63; column

7, lines 26-33; where bids submitted by different advertisers are evaluated in real-time in order to determine which particular advertisement will be displayed to the consumer; transmission of all commercials occurs in real-time).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein transmitting of at least 10% of the commercials occurs within 2 hours of their creation of Dedrick in view of Fuller et al. because Roth et al. teach that the transmitting commercial in real-time provides a very flexible system whereby advertisers can minimize cost and maximize effectiveness (Roth et al., column 2, lines 66-67).

33. As per claim 13, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick in view of Fuller et al. do not teach the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 500 of the targeted prospects.

Roth et al. teach the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 500 of the targeted prospects (see Fig. 1; column 4, lines 7-15; where individualized commercial is selected by bidding; each bidding includes a list of parameter which specify the particular type of viewer which advertiser want to reach (Examiner interprets cost of advertisement is inversely proportional to the number of prospects that can be reached for a commercial, i.e., advertiser will bid for less if it can reach larger population)).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein the step of creating

comprises producing an average of at least one of the individualized commercials for every 500 of the targeted prospects of Dedrick in view of Fuller et al. because Roth et al. teach that such incorporation would provides a very flexible system whereby advertisers can minimize cost and maximize effectiveness (Roth et al., column 2, lines 66-67).

34. As per claim 14, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick in view of Fuller et al. do not teach the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 50 of the targeted prospects.

Roth et al. teach the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 50 of the targeted prospects (see Fig. 1; column 4, lines 7-15; where individualized commercial is selected by bidding; each bidding includes a list of parameter which specify the particular type of viewer which advertiser want to reach (Examiner interprets cost of advertisement is inversely proportional to the number of prospects that can be reached for a commercial, i.e., advertiser will bid for less if it can reach larger population and more for smaller population)).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 50 of the targeted prospects of Dedrick in view of Fuller et al. because Roth et al.

teach that such incorporation would provides a very flexible system whereby advertisers can minimize cost and maximize effectiveness (Roth et al., column 2, lines 66-67).

35. As per claim 15, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick in view of Fuller et al. do not teach the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 10 of the targeted prospects.

Roth et al. teach the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 10 of the targeted prospects (see Fig. 1; column 4, lines 7-15; where individualized commercial is selected by bidding; each bidding includes a list of parameter which specify the particular type of viewer which advertiser want to reach (Examiner interprets cost of advertisement is inversely proportional to the number of prospects that can be reached for a commercial, i.e., advertiser will bid for less if it can reach larger population and more for smaller population)).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein the step of creating comprises producing an average of at least one of the individualized commercials for every 10 of the targeted prospects of Dedrick in view of Fuller et al. because Roth et al. teach that such incorporation would provides a very flexible system whereby advertisers can minimize cost and maximize effectiveness (Roth et al., column 2, lines 66-67).

36. As per claim 16, Dedrick in view of Fuller et al. teach claim 2 as described above.

Dedrick further teaches the method wherein

the marketing characteristics include age, sex, and income (Dedrick, column 3, lines 44-46);

at least one of the components is a video clip and at least another of the components is an audio clip (see column 4, lines 44-55; where audio, video, graphic, animation and text format of advertisement is available but the group of component in any advertisement is as preferred by prospect which is stored in personal profile database); and

Dedrick in view of Fuller et al. do not teach the method wherein transmitting of at least 10% of the commercials occurs within 24 hours of their creation.

Roth et al. teach the method wherein transmitting of at least 10% of the commercials occurs within 24 hours of their creation (see column 5, lines 46-63; column 7, lines 26-33; where bids submitted by different advertisers are evaluated in real-time in order to determine which particular advertisement will be displayed to the consumer; transmission of all commercials occurs in real-time).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein transmitting of at least 10% of the commercials occurs within 24 hours of their creation of Dedrick in view of Fuller et al. because Roth et al. teach that the transmitting commercial in real-time provides a very flexible system whereby advertisers can minimize cost and maximize effectiveness (Roth et al., column 2, lines 66-67).

37. As per claim 17, Dedrick in view of Fuller et al. teach claim 15 as described above.

Dedrick in view of Fuller et al. do not teach the method wherein the step of producing comprises creating an average of at least one of the individualized commercials for every 500 of the targeted prospects.

Roth et al. teach the method wherein the step of producing comprises creating an average of at least one of the individualized commercials for every 500 of the targeted prospects (see Fig. 1; column 4, lines 7-15; where individualized commercial is selected by bidding; each bidding includes a list of parameter which specify the particular type of viewer which advertiser want to reach (Examiner interprets cost of advertisement is inversely proportional to the number of prospects that can be reached for a commercial, i.e., advertiser will bid for less if it can reach larger population)).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method wherein the step of producing comprises creating an average of at least one of the individualized commercials for every 500 of the targeted prospects of Dedrick in view of Fuller et al. because Roth et al. teach that such incorporation would provides a very flexible system whereby advertisers can minimize cost and maximize effectiveness (Roth et al., column 2, lines 66-67).

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Gupta et al. (U.S. Patent No. 6,487,538) teach method and apparatus for local Internet advertising.

McElfresh et al. (U.S. Patent No. 6,907,566) teach method and system for optimum placement of advertisement on webpage.

Merriman et al. (U.S. Pub No. 2003/0028433) teach method of delivery, targeting, and measuring advertising over networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571)270-1374. The examiner can normally be reached on Monday - Friday, 7:30 a.m - 5 p.m, 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)270-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BKS

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11/29/06